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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,473	07/03/2002	Pierre Blanchard	205738US0PCT	2238

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EXAMINER
NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/806,473	BLANCHARD ET AL.	
	Examiner	Art Unit	
	Patrick D. Niland	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1 and 5-18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5533678 Strauch et al..

Strauch discloses the instantly claimed calcium carbonates at the abstract. Column 4, lines 57-62 falls within the scope of the instant claims 7-8 particularly in view of the nebulous language "around". The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee's calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9.

4. Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 10-13 provide for the use of the claimed rheology regulator, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it

merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 10-13 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

B. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 18 recites the broad recitations denoted by “catalyst” and “dehydrating agents”, and the claim also recites narrower limitations denoted by “such as” which is the narrower statement of the range/limitation.

5. Claims 1 and 5-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5533678 Strauch et al..

Strauch discloses the instantly claimed calcium carbonates at the abstract. Column 4, lines 57-62 falls within the scope of the instant claims 7-8 particularly in view of the nebulous language "around". The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee's calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed calcium carbonates as those of the patentee because the patentee encompasses the instantly claimed calcium carbonates and they would have been expected to perform as described by the patentee.

6. Claims 1- 9, 11, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5896904 Ozaki et al..

The calcium carbonate of Ozaki falls within the scope of the instant claims 1-6. Column 3, lines 64-67 falls within the scope of the instant claim 7 particularly in view of the nebulous language "around". The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee's calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9.

7. Claims 1-9, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5896904 Ozaki et al..

The calcium carbonate of Ozaki falls within the scope of the instant claims 1-6. Column 3, lines 64-67 falls within the scope of the instant claim 7 particularly in view of the nebulous language "around". The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee's calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9. US Pat. No. 5896904 Ozaki et al..

The calcium carbonate of Ozaki falls within the scope of the instant claims 1-6. Column 3, lines 64-67 falls within the scope of the instant claim 7 particularly in view of the nebulous language "around". The patentee is silent as to the oil absorption method of the instant claim 9. Since the BET surface area is the same, the patentee's calcium carbonate is expected to necessarily inherently absorb oil in accordance with the instant claim 9. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed calcium carbonates as those of the patentee because the patentee encompasses the instantly claimed calcium carbonates and they would have been expected to perform as described by the patentee.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 703-308-3510. The examiner can normally be reached on Monday to Friday from 10 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone

number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Patrick D. Niland
Primary Examiner
Art Unit 1714